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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,108	06/28/2001	Dwip N. Banerjee	AUS920010309US1	6271
45440	7590	07/05/2005	EXAMINER	
IBM CORPORATION (SS) C/O STREETS & STEELE 13831 NORTHWEST FREEWAY, SUITE 355 HOUSTON, TX 77040			JAROENCHONWANIT, BUNJOB	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/894,108

Applicant(s)

BANERJEE ET AL.

Examiner

Bunjoo Jaroenchonwanit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/19/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This is Office Action is in response to the election filed 101/10/2005, the election with traverse is acknowledged and found persuasive. The restriction requirement is hereby withdrawn. Claims 1-47 are pending for examination. The rejection are as stated below.

The

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, or otherwise lacks patentable utility.
4. Claims 1-28 recite a method, which does not necessary require any form of computer hardware software, to complete the task as recited in the claims. In other words, the method as claimed could be done by a person keeping registration of online service subscriber, manually setting parameters to gradually reducing service to it subscribers. Since, the claims recited known process and not required any form of compute hardware or instruction stored on a computer readable medium, thus, claims 1-28 dictate a process that can be carried on by human being, per se, and constitutes non-statutory subject matter. See, *inter alia*, MPEP § 2106.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 30-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Claim 30 and 31, recite “the system of claim 27” in line 1, there is insufficient antecedent basis for this limitation of the claims.
8. Claim 32 recite “the system of claim 27” and “the potential new subscriber instruction” in line 1, there is insufficient antecedent basis for these limitations of the claim.
9. For compact-examinations’ purpose the phrase “the system of claim 27” in claims 30-31 will be interpreted as “the system of claim 29” and the phrase “the system of claim 27” in claim 32 will be interpreted as “the system of claim 31”. Appropriate corrections are required.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nye (US 2003/0028548).
12. Regarding claims 21, 29 and 46, Nye discloses a method, apparatus and computer readable medium contains instructions, hereinafter a “system” for managing subscriber to an on line service comprising: a subscription service; subscription database; a non-renewal database (¶ 44-45, status of record in databases changes over time, e.g., current previous or expired

subscriber is in database); wherein the non-renewal database comprises non-renewal subscriber records and a post-expiration instruction (§ 46-49, database includes criteria for pre and post expiration 47-48), each non-renewal subscriber record comprising a non-renewal subscriber identification, a subscription expiration condition and data (theses limitations are inherent). Nye does not explicitly disclose the database contains, post expiration access frequency.

However, in the same field of endeavor, Davis teaches a system for online subscription service (§ 32), which includes a database for recording client's activities, including frequency of accessing data from online provider (§ 9). Thus it would have been obvious to one of ordinary skill in the art at the time of the invention was made to include Davis 's idea of tracking user's frequency of accessing online provider and commercialize targeting the particular user with Nye for determining users' behavior after subscription period has expired. Because in doing so, Nye would be able to accurately predict whether the particular subscribers would be interested in or could be induced to renew subscription.

13. Regarding claims 24, 26 and 30-32, Nye-Davis discloses the invention substantially, as applied to, above, including an idea of defining service level, e.g., parameters, that the expired subscriber would receive, such as limiting content accessible or access to member only feature, e.g., sending newsletter. Nye-Davis does not explicitly include selection of service parameters such as download rate, color formatting. Official Notice is taken (see MPEP 2144.03) color formatting and download speed or rate were well known in the art and were utilized as part of different service level in the art the time of the invention was made. Thus, it would have been obvious to one of ordinary skill in the art at the time of the

invention was made that was a matter of choice to include well-known features or the like with a system that is capable of limiting service to an expired member or subscriber, as suggested in Nye-Davis.

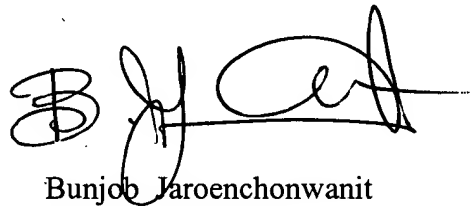
14. Regarding claims 1, 2, 12, 22, 27, 33, 34 and 47, recites a method and computer software in a computer readable medium operable on a computer as applied in claims 30. They are rejected by the same rationale.
15. Regarding claims 3-5, 13-15, 35-37 and 44, Nye-Davis discloses the system capable of lowering service and sending notification (sending newsletter, Nye, ¶ 99).
16. Regarding claims 6, 16 and 38, the method of claim 1, further comprising: (c) accepting renewal of the subscription; and (d) after renewal of the subscription, providing the subscriber with access to the online subscription service at the first level of service during a renewed subscription period (Nye ¶ 44, 48-49).
17. Regarding claims 7, 17 and 39, are reiteration of claims 2, 16 and 39, they are rejection by the same.
18. Regarding claims 8-9, 18-19, 23, and 40-41, Nye-Davis discloses the invention substantially, as applied to claim 1, above, including providing different service level to a user in different category, i.e., sending thank you notes to subscribers (Nye ¶ 49). Thus, using a system that can send thank you notes to paying members to send notification to non-paying member, would have been obvious that was a matter of choice, which being motivated by commercial reasons, e.g., revenue and profit.
19. Regarding claims 10, 20, 25, 28, 42 and 45, Nye-Davis discloses terminating subscriber access to the online subscription service after a specified post-expiration period (Nye, ¶ 48).

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20. Regarding claims 11 and 43, Nye-Davis discloses subscriber is a potential new subscriber and wherein the subscription period is a trial subscription period (Nye, ¶ 44, 46)..

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is (571) 272-3913.

The examiner can normally be reached on 8:00-17:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800.

A handwritten signature in black ink, appearing to read 'Bunjob Jaroenchonwanit', is written over a horizontal line.

Bunjob Jaroenchonwanit  
Primary Examiner  
Art Unit 2143

/bj  
6/24/2005